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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,205	03/12/2004	Nobuyuki Kimura	SUZ-32	8562
20311 7590 03/25/2008 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
NGO, HOANG X				
ART UNIT		PAPER NUMBER		
2852				
MAIL DATE		DELIVERY MODE		
03/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/800,205

**Applicant(s)**

KIMURA, NOBUYUKI

**Examiner**

Hoang Ngo

**Art Unit**

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-32 are pending in this case. Claims 1, 13-15, and 28-32 are independent claims.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al (US 6,782,218).

Sekiguchi et al disclose a printing data transmission apparatus and method for transmitting printing data to a printed matter preparation device 100 to prepare a printed matter constituted of a plurality of pages while inserting a special sheet and a plurality of the special sheets constituting one set into a designated page position sheet by sheet (Col. 22, lines 15-30) comprising insertion information input means 2214 into which insertion information indicating the page position of the special sheet to be inserted in the printed matter is input (Col. 24, lines 1-10, Fig. 13-15); judgment means which

judges whether or not an extra special sheet is generated if the printed matter is prepared in accordance with the insertion information and the number of special sheets constituting one set (Col. 23, lines 54-68); and notification means 2205 which notifies that the extra special sheet is generated, when the judgment means judges that the extra special sheet is generated (Col. 23, lines 45-53).

Sekiguchi et al further disclose acquisition means for acquiring the number of special sheets constituting one set (Col. 24, lines 39-40), wherein the judgment means judges whether or not the extra special sheet is generated if the printed matter is prepared in accordance with the number of special sheets constituting one set acquired by the acquisition means; the notification means notifies the generation of the extra special sheet before the printing data is transmitted to the printed matter preparation device, when the judgment means judges the generation of the extra special sheet (Col. 23, lines 44-53); the judgment means judges whether or not the extra special sheet is generated if the printed matter is prepared based on the number of special sheets inserted in a case where the printed matter is prepared in accordance with the insertion information and the number of special sheets constituting one set (Col. 23, lines 54-67); the notification means includes display means to indicate that the extra special sheet is generated, when the judgment means judges that the extra special sheet is generated (Col. 23, lines 44-53); the display means displays information indicating a request for re-input of the insertion information; the notification means notifies that automatic addition is performed to add the extra special sheet to the end of the printed matter; selection acceptance means which accepts selection from a plurality of choices including at least

one of input of the insertion information (Col. 19, line 58 – Col. 20, line 24); the display means displays information indicating a request for selection from a plurality of choices including at least one of re-input of the insertion information, automatic addition to add the extra special sheet to the end of the printed matter, and forced execution of the printing, when the judgment means judges that the extra special sheet is generated (Col. 19, line 24 – Col. 20, line 24).

### ***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Ngo whose telephone number is (571) 272-2138. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571) 272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2852

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hoang Ngo/  
Primary Examiner, Art Unit 2852

HN  
March 13, 2008